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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,405	11/04/2003	Moshe Rock	10638-067001	5742
26161	7590	03/31/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PIERCE, JEREMY R	
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			1771	
DATE MAILED: 03/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,405

Applicant(s)

ROCK ET AL.

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 6,10 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9,11-20 and 26-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/2/04, 1/13/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-40 in the reply filed on December 15, 2005 is acknowledged.
2. Applicant's election without traverse of Species (1), where areas of the outer surface adjacent said discrete areas are free of coating material in the reply filed on January 17, 2006 is acknowledged. Applicant states that this species reads on claims 4, 5, and 7-9, while claims 1-3 and 11-40 are generic. Claims 6 and 10 are withdrawn from consideration. However, upon further examination of the claims, the Examiner is setting forth another election of species requirement, as set forth below. Therefore, the generic claims will be different.
3. This application contains claims directed to the following patentably distinct species: (1) reverse plaited circular knit, (2) double needle bar warp knit, (3) non-reverse plaiting circular knit, and (4) Raschel warp knit. The species are independent or distinct because each knitted construction constitutes a separate invention.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 11-16, and 26-40 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. During a telephone conversation with Timothy French on March 28, 2006 a provisional election was made without traverse to prosecute the invention of the reverse plaited circular knit construction, claims 17-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-25, along with claims 6 and 10 as set forth above in Section 2, are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Amendment

5. Applicant's amendment filed on January 17, 2006 has been entered. Claims 41-61 have been cancelled. Claims 1-40 remain pending, with claims 6, 10, and 21-25 withdrawn from consideration being drawn to a non-elected species.

Drawings

6. Replacement drawings were received on January 17, 2006. These drawings are accepted by the Examiner.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites the "spandex is added to the yarn at the outer surface in air cover." How is yarn added in air cover? "Air cover" is not a term of art, and it is unclear what the meaning of this limitation is supposed to be.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5, 7-9, 11, 12, 14, and 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lumb et al. (U.S. Patent No. 5,364,678).

With regard to claim 1, Lumb et al. disclose a composite fabric comprising an inner layer of fabric, an outer layer of fabric, and adhesive layers (Abstract). The inner fabric layer would meet the fabric limitations in the claim because it may have a knitted construction with one surface having raised fibers (column 2, lines 26-38). The outer fabric layer could also meet the fabric limitations in the claim because it may have a knitted construction (column 5, line 46) and one surface having raised fibers (column 7, lines 14-16). At least one of the fabric layers will have a discontinuous coating of adhesive on the flat side (column 4, line 55 – column 5, line 22). The adhesive would provide the bound groupings of yarn and enhance abrasion resistance because adhesive is more abrasive than synthetic yarn. Either spun or filament yarn may be used for the loop and stitch yarns (column 5, lines 46-47). With regard to claims 2 and 3, the adhesive is applied in a discontinuous pattern and would therefore not have substantial effect on the various properties of the knit fabric. With regard to claims 4, 5, and 32, areas substantially free of coating would exist because the coating is discontinuous. With regard to claims 7-9, there would exist contrasting performance characteristics between areas that have adhesive and areas that do not. With regard to claim 11, the adhesive would prevent fiber pilling because the fibers would be bound to the adhesive. With regard to claim 12, since the fibers are similar in the knit fabric, a group of yarn fibers will inherently possess higher tenacity than any single fiber by itself. With regard to claim 14, the fabric may comprise polyester (column 3, line 42 and column 4, line 47). With regard to claim 33, the fabric is used in outerwear (column 1, lines 25-30). With regard to claims 34-36, the coated area would comprise the entire

Art Unit: 1771

fabric, since Lumb et al. do not teach applying it in discrete sections. Once the fabric was made into a garment, the areas would be present in both the elbow and shoulder regions.

11. Claims 1-5, 7-9, 11, 12, 14, 15, and 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Scherbel (U.S. Patent No. 5,922,433).

With regard to claim 1, Scherbel disclose an elastic interlining fabric (Abstract). The fabric is formed of multi-filament yarns (column 3, lines 60-67) into a knitted fabric (column 4, line 35). One surface of the knitted fabric is napped and the other surface is provided with a discontinuous coating of adhesive (column 4, lines 38-42). The adhesive would provide the bound groupings of yarn and enhance abrasion resistance because adhesive is more abrasive than synthetic yarn. With regard to claims 2, 3, and 15, the adhesive is applied in a dot pattern (column 4, line 42) and would therefore not have substantial effect on the various properties of the knit fabric. With regard to claims 4, 5, and 32, the dot pattern of adhesive would create areas substantially free of coating adjacent the dots. With regard to claims 7-9, there would exist contrasting performance characteristics between areas that have adhesive and areas that do not. With regard to claim 11, the adhesive would prevent fiber pilling because the fibers would be bound to the adhesive. With regard to claim 12, since the fibers are similar in the knit fabric, a group of yarn fibers will inherently possess higher tenacity than any single fiber by itself. With regard to claim 14, the fibers may comprise polyester (column 3, line 44). With regard to claim 33, the fabric is used in clothing (column 1, lines 7-9). With regard to claims 34-36, the coated area would comprise the entire fabric, since Scherbel does not

Art Unit: 1771

teach applying it in discrete sections. Once the fabric was made into a garment, the areas would be present in both the elbow and shoulder regions.

12. Claims 1-5, 7-9, 11, 12, 14, 15, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Usher et al. (U.S. Patent No. 5,789,058).

With regard to claim 1, Usher et al. disclose a hook and loop closure element (Abstract). Multi-filament polyester yarn is knitted into a fabric to provide raised fibers in the form of surface loops (column 1, line 60 – column 2, line 9 and Figure 8). Afterward, a discontinuous coating is applied to the backside of the fabric in order to bond a portion of the loops (column 2, lines 27-45). The adhesive would provide the bound groupings of yarn and enhance abrasion resistance because adhesive is more abrasive than synthetic yarn. With regard to claims 2 and 3, the adhesive is applied in a discontinuous pattern (See Figure 8) and would therefore not have substantial effect on the various properties of the knit fabric. With regard to claims 4, 5, and 32, areas substantially free of coating are adjacent the resin (See Figure 8). With regard to claims 7-9, there would exist contrasting performance characteristics between areas that have adhesive and areas that do not. With regard to claim 11, the adhesive would prevent fiber pilling because the fibers would be bound to the adhesive. With regard to claim 12, since the fibers are similar in the knit fabric, a group of yarn fibers will inherently possess higher tenacity than any single fiber by itself. With regard to claim 14, the fabric may comprise polyester (column 1, line 67). With regard to claim 15, the portions of adhesive in Figure 8 may be characterized as dots, albeit large ones. With regard to claim 33, a recitation of the intended use of the claimed invention must result in a

structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, no structure of wearing apparel is described in claim 33.

Claim Rejections - 35 USC § 102

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 39 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lumb et al.

Lumb et al. do not disclose applying the coating using a single head rotary screen. However, such a limitation is merely a process of manufacturing step in a product claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Even if the coating were not applied using a single head rotary screen in Lumb et al., it still

meets the structural limitations of the claimed product because the claim only requires that it be non-continuous, which Lumb et al. anticipate.

15. Claim 39 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scherbel.

Scherbel does not disclose applying the coating using a single head rotary screen. However, such a limitation is merely a process of manufacturing step in a product claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Even if the coating were not applied using a single head rotary screen in Scherbel, it still meets the structural limitations of the claimed product because the claim only requires that it be non-continuous, which Scherbel anticipates.

16. Claim 39 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Usher et al.

Usher et al. do not disclose applying the coating using a single head rotary screen. However, such a limitation is merely a process of manufacturing step in a product claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in

Art Unit: 1771

the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Even if the coating were not applied using a single head rotary screen in Usher et al., it still meets the structural limitations of the claimed product because the claim only requires that it be non-continuous, which Usher et al. anticipate.

Claim Rejections - 35 USC § 103

17. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. in view of Rock et al. (U.S. Patent No. 5,896,758).

With regard to claim 13, Lumb et al. do not teach the tenacity of the yarn fibers. Rock et al. also disclose a knit fabric used in the lining of apparel (column 1, lines 5-17). Rock et al. teach that yarns with a tenacity of between 6 and 12 grams per denier will increase abrasion and tear resistance (column 3, lines 6-11). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use yarn with a tenacity greater than 5 grams per denier in the invention of Lumb et al. in order to provide improved abrasion and tear resistance, as taught by Rock et al.

With regard to claim 26, Lumb et al. do not teach including elastomeric yarn. Rock et al. teach that incorporating elastomeric yarn into the knit will enhance softness and flexibility. It would have been obvious to a person having ordinary skill in the art at the time of the invention to incorporate elastomeric yarn into the knit of Lumb et al. in order to improve softness and flexibility, as taught by Rock et al.

Art Unit: 1771

18. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherbel in view of Rock et al. (U.S. Patent No. 5,896,758).

With regard to claim 13, Scherbel does not teach the tenacity of the yarn fibers. Rock et al. also disclose a knit fabric used in the lining of apparel (column 1, lines 5-17). Rock et al. teach that yarns with a tenacity of between 6 and 12 grams per denier will increase abrasion and tear resistance (column 3, lines 6-11). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use yarn with a tenacity greater than 5 grams per denier in the invention of Scherbel in order to provide improved abrasion and tear resistance, as taught by Rock et al.

With regard to claim 26, Scherbel does not teach including elastomeric yarn. Rock et al. teach that incorporating elastomeric yarn into the knit will enhance softness and flexibility. It would have been obvious to a person having ordinary skill in the art at the time of the invention to incorporate elastomeric yarn into the knit of Scherbel in order to improve softness and flexibility, as taught by Rock et al.

19. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. in view of Dutta et al. (U.S. Patent No. 5,804,011).

Lumb et al. do not disclose what composition should be used for the adhesive used to bond the knitted fabric. Dutta et al. also disclose a composite fabric material comprising a knitted fabric (column 10, lines 55-67). Dutta et al. disclose that polyurethane applied discontinuously to the knitted fabric gives satisfactory results with high strength (column 11, line 17 – column 12, line 12). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use polyurethane

adhesive in the knitted composite of Lumb et al. in order to provide sufficient strength for making the composite fabric, as taught by Dutta et al.

20. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scherbel in view of Dutta et al.

Scherbel does not disclose what composition should be used for the adhesive used to bond the knitted fabric. Dutta et al. also disclose a composite fabric material comprising a knitted fabric (column 10, lines 55-67). Dutta et al. disclose that polyurethane applied discontinuously to the knitted fabric gives satisfactory results with high strength (column 11, line 17 – column 12, line 12). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use polyurethane adhesive in the knitted composite of Scherbel in order to provide sufficient strength for making the composite fabric, as taught by Dutta et al.

21. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. in view of Rock et al. (US 2001/0046580).

Lumb et al. disclose using a circular weft knit construction (column 5, lines 45-46), but do not teach using a reverse plaited circular knit construction. The '580 Publication discloses that using a reverse plaiting technique in circular knit fabrics can provide dynamic thermal insulation properties (paragraphs 7 and 8). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use a reverse plaited circular knit fabric in Lumb et al. in order to increase thermal insulation, as taught by the '580 Publication. With regard to claim 18, the '580 Publication teaches that the loop yarn should be greater in size than the stitch yarn (paragraph 21). With

Art Unit: 1771

regard to claims 19 and 20, the '580 Publication teaches the loop yarn to have a dpf as low as 0.5 (paragraph 19) and the stitch yarn to have a dpf as high as 3.0 (paragraph 20).

22. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherbel in view of Rock et al. (US 2001/0046580).

Scherbel does not teach using a reverse plaited circular knit construction. The '580 Publication discloses that using a reverse plaiting technique in circular knit fabrics can provide dynamic thermal insulation properties (paragraphs 7 and 8). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use a reverse plaited circular knit fabric in Scherbel in order to increase thermal insulation, as taught by the '580 Publication. With regard to claim 18, the '580 Publication teaches that the loop yarn should be greater in size than the stitch yarn (paragraph 21). With regard to claims 19 and 20, the '580 Publication teaches the loop yarn to have a dpf as low as 0.5 (paragraph 19) and the stitch yarn to have a dpf as high as 3.0 (paragraph 20).

23. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. in view of Rock et al. (US 2002/0122914).

With regard to claims 26 and 27, Lumb et al. do not teach including elastomeric yarn. The '913 Publication also teaches a knitted fabric comprising a raised surface useful in clothing (Abstract). The '913 Publication discloses that it is known to plait spandex fibers into the knit. It would have been obvious to a person having ordinary skill in the art at the time of the invention to incorporate elastomeric yarn into the knit of

Lumb et al. in order to improve the elasticity of the material, as taught to be known by the '913 Publication. With regard to claims 28 and 29, modifying the process of how the elastomeric yarns are incorporated into the knitted fabric would have little material effect on the final knitted product.

24. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherbel in view of Rock et al. (US 2002/0122914).

With regard to claims 26 and 27, Scherbel do not teach including elastomeric yarn. The '913 Publication also teaches a knitted fabric comprising a raised surface useful in clothing (Abstract). The '913 Publication discloses that it is known to plait spandex fibers into the knit. It would have been obvious to a person having ordinary skill in the art at the time of the invention to incorporate elastomeric yarn into the knit of Scherbel in order to improve the elasticity of the material, as taught to be known by the '913 Publication. With regard to claims 28 and 29, modifying the process of how the elastomeric yarns are incorporated into the knitted fabric would have no patentable effect on the final knitted product.

25. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. in view of Muramoto et al. (U.S. Patent No. 5,352,518).

Lumb et al. do not disclose using core sheath fibers with the core being elastomeric. Muramoto et al. teach that elastomeric core fibers with a thermoplastic sheath offer a fiber with good stretch recovery and excellent feeling to the wearer (column 1, line 65 – column 2, line 5). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use core sheath fibers with

Art Unit: 1771

elastomeric cores in the fabric of Lumb et al. in order to provide stretch recovery and excellent feeling to the wearer, as taught by Muramoto et al.

26. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherbel in view of Muramoto et al.

Scherbel does not disclose using core sheath fibers with the core being elastomeric. Muramoto et al. teach that elastomeric core fibers with a thermoplastic sheath offer a fiber with good stretch recovery and excellent feeling to the wearer (column 1, line 65 – column 2, line 5). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use core sheath fibers with elastomeric cores in the fabric of Scherbel in order to provide stretch recovery and excellent feeling to the wearer, as taught by Muramoto et al.

27. Claims 37, 38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. in view of Rock et al. (US 2002/0025747).

With regard to claims 37 and 38, Lumb et al. do not disclose how much adhesive to use. The '747 Publication teaches a composite fabric material useful in apparel (Abstract). The '747 Publication discloses that a discontinuous adhesive layer should be applied in an amount between 0.25 and 2.5 osy (paragraph 32). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use between 0.25 and 2.5 osy of adhesive in the fabric of Lumb et al. in order to provide a material useful in clothing applications, as taught by the '747 Publication. With regard to claim 40, the limitation of the single head rotary screen is a limitation on the apparatus used to create the claimed fabric product, and thus represents a process of

Art Unit: 1771

manufacture limitation of applying adhesive. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Even if the coating were not applied using a single head rotary screen in Lumb et al., the amount of adhesive applied is still obvious in view of the teachings of the '747 Publication.

Double Patenting

28. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

29. Claims 1-5, 7-9, 11-20, and 26-40 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/650,098. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '098 Application teaches a composite fabric having one surface coated with a discontinuous coating and another surface having raised features.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

30. Claims 1-5, 7-9, 11-20, and 26-40 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/911,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '855 Application teaches a composite fabric having one surface coated with a discontinuous coating and another surface having raised features.

31. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

32. Claims 1-5, 7-9, 11-20, and 26-40 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/960,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '402 Application teaches a composite fabric having one surface coated with a discontinuous coating and another surface having raised features.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

33. Claims 1-5, 7-9, 11-20, and 26-40 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 11/001,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '893 Application teaches a composite fabric having one surface coated with a discontinuous coating and another surface having raised features.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

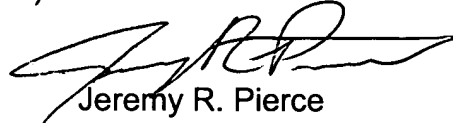
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1771

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. R. Pierce', is positioned above the printed name.

Jeremy R. Pierce
Examiner
Art Unit 1771

March 28, 2006